

### **REMARKS**

Claims 1 and 4-21 are amended and are now pending. Claim 2 has been canceled. In view of the above amendments to the claims and the legal reasoning urged below to demonstrate why the 35 U.S.C. § 103 rejections are improper, Applicant respectfully requests the Examiner to reconsider the outstanding rejections and to withdraw them.

#### ***35 U.S.C. § 112 Rejections***

Claims 1-2 and 4-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended the claims to obviate this rejection. Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### ***35 U.S.C. § 103 Rejections***

##### ***A. Governing Criteria***

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his

or her skill...[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the

claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

#### B. Discussion of Rejections

Claims 1-2, 4-5, 7-13, 15-18, and 20-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,374,357 to Mohammed et al., and further in view of Brody's U.S. Publication No. 2001/0051928 and U.S. Patent No. 6,907,396 to Muttik et al. Applicant respectfully traverses this rejection.

Mohammed, Brody and Muttik are three disparate references that involve solving three different problems such that when one of ordinary skill confronted with the same problem as the inventor of the present invention as claimed would not have selected the elements and combined them in the manner claimed.

Mohammed's system is a closed platform. As such, Mohammed is directed to a system and method that permits a vendor of a **distributed application**, such as a computer game, to selectively provide permissions to network service providers for using **the vendor's distributed applications**. Col. 19, lines 27-31 (emphasis added). In other words, the system is only open to those developers who possess the required credentials. i.e., a valid permit. See col. 3, line 1 –

col. 4, line 32. Mohammed is silent on the security of the actual software run throughout the environment. In fact, Mohammed's only concern is that the network providers are authorized to provide the services for the distributed applications. As a result, Mohammed is not concerned with providing security on an open platform as claimed.

The Examiner provides cites that do not relate to the present invention as claimed. For example,

Program step 301 corresponds to the executable instructions that would be performed at the client computer (Client B in FIG. 6) that function to generate a Request permit data packet. Col. 18, lines 13-15.

does not correspond to "loading software on said computer system suitable for operating on the computer system" as the Examiner has stated. Mohammed is disclosing software that is used to request a permit. This is not the software to be loaded on a host and validated.

As another example, the Examiner cites col. 18, line 56 – col. 19, line 15 as disclosing "upon loading the software on the open platform computer system, validating the software by the use of a validator program residing in the open platform computer system in a secure fashion such that the validator program scans the software that is loaded in the secure environment" as amended. However, the verification Mohammed discloses verifies the validity of the verification data **in the permit, such as the authenticity of the digital signature**. Mohammed does not verify (or validate as presently claimed) any of the distributed software running on any of the clients. It does not need to, since it is a closed system. As such, one ordinarily skilled in the art would not look to Mohammed for any teaching or suggestion of the present claims. For this reason alone, Applicant respectfully submits the claims are allowable over the cited references.

Brody does not cure Mohammed's deficiencies. Like Mohammed, Brody describes a **closed** platform that protects the **publisher** from its software being copied and distributed in an unauthorized manner. For example, Fig. 3 discloses a process in which the software publisher is in complete control of the software distribution, including the personalization process.

The Examiner states "Brody teaches a PDA coupled to a host device for personalization purposes. Furthermore, Brody et al. teach[es] that one of the steps during the personalization process may be to scan the software before allowing it to be downloaded to the PDA to prevent

from downloading an application with malicious code (para. 105). Office Action, page 3-4. The cite is provided below for convenience:

It should be noted that while a personalization according to the present invention can be authenticated by the use of a digital signature, the goals and processes of applying a personalization are completely distinct from those of authenticating the software itself (such as for Java-based software, as previously discussed, which results in a "signed software application" or "signed archive"). As already detailed, the goal of authenticating software (such as a Java software application or archive) is to protect the user from possibly-malicious effects of untrusted software, and the process of doing so basically involves only the applying of a digital signature to the software and the subsequent validation thereof at run-time, according to well-known methods of public-key cryptography. In contrast, as disclosed herein, the goal of applying a personalization to software, with or without authentication, is to protect the software itself (and the software publisher who developed the software) by affording some degree of protection against unauthorized copying and distribution. Moreover, the processes of applying a personalization, as detailed herein, involve novel methods that are different from the mere application of a digital signature, although digital signatures may be used as part of these processes to protect the applied personalization against tampering and forgeries. Brody, para 105.

Nowhere in the Examiner's cite, indeed, nowhere in Brody, is it stated that the personalization process scans any software before allowing it to be downloaded to a PDA. The use of the phrase by the Examiner "one of the steps...**may** be to scan the software" reveals that suggestion for this element comes from the Applicant's disclosure, not Brody.

Furthermore, the Brody cite teaches away from the present invention as claimed. Brody states "the goal of applying a personalization to software, with or without authentication, is to **protect the software itself (and the software publisher who developed the software)** by affording some degree of protection against unauthorized copying and distribution." This is not "ensuring the security of a computer system" as claimed.

Moreover, in the same citation Brody also states

the goals and processes of applying a personalization are completely distinct from those of authenticating the software itself (such as for Java-based software, as previously discussed, which results in a "signed software application" or "signed archive"). As already detailed, the goal of authenticating software (such as a Java software application or archive) is to protect the user from possibly-malicious **effects of untrusted software**, and the process of doing so basically involves **only** the applying of a digital signature to the software and the subsequent

validation thereof at run-time, according to well-known methods of public-key cryptography. Para. 105 (emphasis added).

Only applying a digital signature to software does ensure that the software is not malicious. Digital signatures only ensure that the sender is a trusted sender (i.e., that the sender is who the sender says he/she is). Digital signatures provide NO security against malicious code that is distributed with valid digital signatures attached to the code. As such, Brody does not provide for validating the software in a secure environment as claimed. As such, one ordinarily skilled in the art would not look to Brody for any teaching or suggestion of the present claims.

Muttik does not cure the deficiencies of Mohammed and Brody. Muttik is limited to running emulation code on a **closed** system. Muttik does not disclose all the elements of ensuring security of an open platform computer system as claimed.

Mohammed, Brody, and Muttik, alone or in combination, do not disclose, teach, or suggest each and every element of the claims as required. As argued above, one ordinarily skilled in the art would not look to combine these references because of their quite disparate teachings. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 6, 14, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,374,357 to Mohammed et al., and further in view of Brody's U.S. Publication No. 2001/0051928 and U.S. Patent No. 6,907,396 to Muttik et al. as applied to claims 1, 8, and 18 above, and in further view of U.S. Patent No. 6,948,070 to Ginter et al. Applicant respectfully traverses this rejection.

As argued with regard to claims 1, 8, and 18, Mohammed, Brody, and Muttik, alone or in combination, do not teach or suggest the present claims. Ginter does not cure the Mohammed-Brody-Muttik combination's deficiencies. Ginter is directed towards electronic commerce transactions. Again, another disparate reference that bears little relation to the other cited references and the present claims. Accordingly, Applicant respectfully requests withdrawal of this rejection.

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**CONCLUSION**

In light of the above amendments and remarks, Applicant respectfully requests reconsideration of the rejected claims and solicits their allowance. In the event an interview is useful in resolving any issues, the Examiner is invited to telephone the undersigned representative.

Respectfully submitted,

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